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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,986	09/22/1999	MOTOYOSHI MURAKAMI	00177/530155	4038

7590 10/07/2004

WENDEROTH LIND & PONACK LLP  
2033 K STREET NW SUITE 800  
WASHINGTON, DC 20006

EXAMINER
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TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/400,986

Applicant(s)

MURAKAMI ET AL.

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-21,23-26,28-35,37,38,40-42,44-48 and 51-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-26,28-35,37,38,40-42,44,45,47,48 and 51-60 is/are allowed.
- 6) ☒ Claim(s) 2-21, 53, 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2134

### DETAILED ACTION

1. This office action is in response to Applicant's Request for Continued Examination (RCE) filed on 7/30/2004. Claims 2-10, 23-26, 28-32, 34-35, 37-38, 40-42, 44-45, 48, 51-52 have been amended. Claims 11, 13, 15, 17-20, 33 and 47 are previously presented. Claims 1, 22, 27, 36, 39, 43, 46 and 49-50 have been cancelled. Claims 53-61 have been added. Claims 2-21, 23-26, 28-35, 37-38, 40-42, 44-48 and 51-61 are pending.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

*2-21, 53 and 61*

Claim ~~53~~ is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed limitations recite an optical disk including some recording areas with its intended use. Therefore, it is directed to non-statutory subject matter because an optical disk is a non-functional descriptive material (e.g. music on a computer readable medium). *pm*

Claims 2-21 and 61 are rejected because by their dependency they contain the language of the independent claim.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2134

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 61 recites the limitation "the third data" on page 16. There is insufficient antecedent basis for this limitation in the claim.

***Allowable Subject Matter***

4. Claims 23-26, 28-35, 37-38, 40-42, 44-45, 47-48 and 51-60 are allowed.

The following is an examiner's statement of reasons for allowance:

The closest prior art, Maeda et al. (U.S. Patent No. 5,764,607) fails to teach the claimed limitation reciting "reproducing data from the second recording area before reproducing data from the first recording area; deciding, based on an identifier in the control data, whether the second recording area comprises a third section for recording data to be inhibited from being externally outputted from the at least one of a recording apparatus and reproducing apparatus; and processing the data to be inhibited from the second recording area are determined to include data to be inhibited from being outputted, without outputting the data to be inhibited from being outputted, wherein the identifier indicates whether the second recording area further includes the third section for recording the data to be inhibited from being outputted from the at least one of a recording apparatus and reproducing apparatus". The cited prior art, either singularly or in combination, fails to render the above underlined features obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

Art Unit: 2134

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690 or (571) 272-3842 after 10/21/2004. The examiner can normally be reached on 8:30-5:00 M-F.

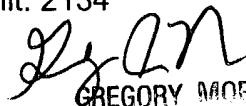
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789 or (571) 272-3838 after 10/21/2004. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT

September 30, 2004

Examiner: Tongoc Tran  
Art Unit: 2134

  
GREGORY MORSE  
SUPERVISOR  
TECHNOLOGY CENTER 2100